

REMARKS

Claims 1, 2, 4-9 and 11-17 are pending. Claims 1, 8 and 15-17 are the independent claims. Favorable reconsideration is respectfully requested.

Claims 1, 2, 4-9 and 11-17 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent 6,314,569 (Chernock et al.). Applicant traverses.

Claim 1 recites, inter alia, an inserting unit which inserts into the image source an image marking including information that is used to display the network data synchronizing with displaying of the image source and which is extracted from the image source. In particular, the inserting unit (a) produces a feature file used for moving picture matching based on the image source, (b) inserts the image marking including a description about a location where the feature file is stored, into the image source, and (c) produces a synchronizing information script, generated with the feature file.

The synchronizing information script shows when the network data are displayed and allows identification of web contents related to points in the image source. This feature is not found in Chernock et al.

In order to set forth a prima facie case of anticipation requires that each and every limitation of the claim be identified by the Examiner in a single reference. Moreover, each word of the claim must be accorded patentable weight in reading the limitations of the claim on a prior art reference. It is entirely improper to examine the “gist” of an invention. However, in the final Office Action, this is exactly what was done.

The recited synchronizing information script: 1) is generated with the feature file; 2) shows when the network data are displayed; and 3) allows identification of web contents

related to points in the image source. In order to meet this limitation requires that a particular script be identified in Chernock et al. that meets *all three of these requirements*. The Office Action has failed to do so.

The portion of Chernock et al. relied upon in the Office Action as allegedly corresponding to the recited synchronizing information script relates to a script, exemplified in the discussion of the Presentation Time Stamp (PTS). The PTS shows beginning and ending times of a “hole” specification, the hole being a portion of audio or video at which there is no significant audio or video activity. The fact that the hole time stamp, i.e., the PTS, appears every frame to every third frame, is sufficient to use it for synchronization, since the frame rate is known. Col. 4, lines 56-62.

The PTS time stamp may be useful for synchronization, taking advantage of the known frame rate. However, there is no teaching or suggestion in Chernock of the recited synchronization script that 1) is generated with the feature file, 2) shows when the network data are displayed, and 3) allows identification of web contents related to points in the image source. As such, it is believed that a prima facie case of anticipation has not been set forth in the Office Action. For at least this reason, claim 1 is believed patentable over Chernock et al.

Not only are these limitations not identified in the prior art in the Office Action, but it is clear from the words of the Office Action that there is no recognition of the requirement that they *be* identified to establish a prima facie case of anticipation.

In the Response to Arguments, starting at the bottom of page 5 of the Office Action, in response to the Applicant having previously pointed out the above deficiency of the rejection, the Examiner said “Chernock teaches in col. 4, lines 10-25 the use of a file which is *deemed functionally equivalent* to applicant’s synchronization script *by way of broadest reasonable interpretation* and also teaches how the file (script) is used in col. 4, lines 56-66 to

perform the proper media synchronization procedures.” Office Action at pages 5-6 (emphasis added).

First, the fact that synchronization is done using the PTS is not enough to meet the elements of claim 1, as has been described in detail above. The PTS does not correspond to each and every limitation of the claimed synchronization script and therefore cannot be used to correspond to that element in an anticipation rejection.

Second, the Examiner appears to be utilizing a new principle of law to support the rejection. Instead of the prior art having to meet each and every limitation of the claim, the Office Action appears to have utilized the principle that any prior art element “deemed *functionally equivalent*” to the recited element can be used to meet that element in an anticipation rejection. This is not the law.

There are countless patents relating to devices and methods for performing functions performed previously in other ways. Even if it were true that the PTS performed the same function as the applicant’s synchronization script, and it is *not* conceded that it is true, it would be not be enough to meet the claim limitation. Equivalence of function is not the test for anticipation; identity of structure is the test. That test has not been met.

Moreover, as to the Examiner’s reference to the “broadest reasonable interpretation,” such an interpretation cannot properly ignore actually claimed limitations. It is certainly not “reasonable” to interpret a claim by ignoring limitations that have been explicitly recited, which is exactly what the Office Action has done.

In summary, the Examiner has improperly examined the gist of Applicant’s invention by: 1) failing to give patentable weight to each and every word in the claim; and 2) by applying a newly-formulated “equivalence of function” test for anticipation when the law

requires the "identity of structure" test. In view of the above, no prima facie case of anticipation has been set forth in connection with claim 1.

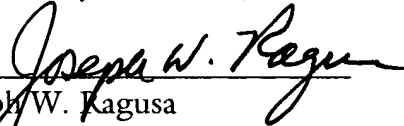
Amended independent claims 8 and 15-17 recite a substantially similar feature and are believed patentable for similar reasons.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

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Respectfully submitted,

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